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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,758	12/03/2003	Roy Schoenberg	57581-034 (SHOL-120)	4221

7590 06/13/2006  
McDermott, Will & Emery  
28 State Street  
Boston, MA 02109

EXAMINER

LEWIS, CHERYL RENE A

ART UNIT PAPER NUMBER

2167

DATE MAILED: 06/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/726,758

Applicant(s)

SCHOENBERG, ROY

Examiner

Cheryl Lewis

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-54 is/are rejected.
- 7) ☒ Claim(s) 2-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/9/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-54 are presented for examination.

### ***INFORMATION DISCLOSURE STATEMENT***

2. The information disclosure statements filed on February 9, 2004, complies with the provisions of MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered as to the merits.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 9, 21, 41, and 47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

#### **MPEP 2106 IV.B.2.(b)**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

5. Claims 1, 9, 21, 41, and 47 are not statutory because the claims do not produce a tangible result.

The independent claims comprise a practical application, but the practicality of the application recited in the independent claims do not produce tangible results. Again, these independent claims are not statutory because they merely recite a number of computing steps without producing any tangible results within the technological arts. These independent claims recite a series of computing steps for associating a field descriptor with a text string and a value of a record. The claims do not specifically recite any of the following examples of tangible results: any manipulation of the data to produce a transformation of the data, a display of the data which could be accessed by a user, a copy operation of the data (snapshot), or storage of the data to enable space to be available for further processing, etc.

### ***Claim Objections***

6. Claims 2-8 are objected to because of the following informalities:

Dependent claims 2-8 recite "data conversion" method and independent claim 1 recites "text-generation" method. Since claims 2-8 are dependent on independent claim 1, then these claims should also recite "text-generation". There does not appear to be any consistency between independent claim 1 and dependent claims 2-8. Also, the limitations of claim 1 do not recite "data conversion".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. (Pat. No. 5,781,897 Filed April 18, 1996, hereinafter Chen).

9. Regarding Claims 1, 9, 21, 41, and 47, Chen teaches a method and system for performing record searching in a database within a computer peripheral storage unit.

The method and associated system for a method and system for performing record searching in a database within a computer peripheral storage unit as taught or suggested by Chen includes:

receiving data records (col. 4, lines 24-45), wherein each data record includes one or more data fields and a field value associated with each data field (col. 4, lines 24-45); searching a plurality of text strings (col. 3, lines 55-67, col. 4, lines 1-16); a text-string for each data record (col. 4, lines 1-23), wherein each text-string includes one or more text-based data descriptors (col. 4, lines 1-23), such that each data descriptor includes: a field descriptor that defines a specific data field within the data record to which the text-string is related (col. 4, lines 1-23), and a value descriptor that defines the field value associated with the specific data field (col. 4, lines 1-23);

defining a first target value for each of one or more data fields within a database record structure of a database (col. 4, lines 24-67, col. 5, lines 1-67, col. 6, lines 1-19);  
and

generating a first result set by identifying one or more text-strings that include a value descriptor that is essentially equivalent to at least one of the first target values (col. 4, lines 24-67, col. 5, lines 1-67, col. 6, lines 1-19).

10. Regarding Claims 2, 12, 22, 32, and 48, Chen teaches storing the text-strings as a text-based data file (col. 3, lines 10-54).

11. Regarding Claims 3, 13, 23, 33, and 49, Chen teaches the means which essentially comprises the same means as ASCII file (col. 3, lines 55-67).

12. Regarding Claims 4, 14, 24, 34, and 50, Chen teaches a record identifier that identifies the data record to which the text-string is related (col. 4, lines 24-67, col. 5, lines 1-67, col. 6, lines 1-19).

13. Regarding Claims 5, 15, 25, 35, and 51, Chen teaches each data descriptor includes one of characters (col. 4, lines 24-67, col. 5, lines 1-67, col. 6, lines 1-19).

14. Regarding Claims 6-8, 16-20, 26-28, 30, 31, 35-40, 42-46, and 52-54, the limitations of these claims have been noted in the rejections above. They are therefore rejected as set forth above.

#### **NAME OF CONTACT**

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone

Art Unit: 2167

number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

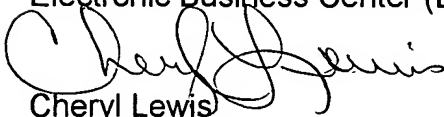
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Lewis  
Patent Examiner  
June 9, 2006